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DIVISIONPractitioner's Docket No. 2008 NOV 12 PM 4: 54**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**☒ In re application of:Application No.: 10 / 788,620Group No.: 2614Filed: 27 February 2004Examiner: Hemant Shantilal PatelFor: Xian-He SUN et al.☐ Patent\*: METHOD OF INFORMING A CALLEE OF AN ATTEMPTED TELEPHONE CALL BY MEANS  
Issued: OF INTERNET PROTOCOL MESSAGING

*NOTE: Insert name(s) of inventor(s) and title also for patent. Where request is with respect to a maintenance fee payment also insert application number and filing date and add Box M. Fee to address.*

Mail Stop 16

Director of the U.S. Patent and Trademark Office

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**REQUEST FOR REFUND  
(IMPROPER CHARGE OF DEPOSIT ACCOUNT)**

*NOTE: 37 C.F.R. § 1.26(b) "Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable."*

**I. REFUND REQUEST**

This is a request for a refund, with respect to the charge to Deposit Account  
19-3550 shown on the statement dated October 2008, for the  
above-identified

☒ application.☐ patent.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on

06 November 200806 Nov. 2008  
DateSignature 

(check the following, if desired, and supply copy of statement)

- ☒ A copy of the monthly statement, in which the error referred to occurs, accompanies this request.

## II. FEES CHARGED FOR WHICH REFUND REQUESTED

	AMOUNT OF REFUND REQUESTED
<input type="checkbox"/> Filing fee	_____
<input type="checkbox"/> Surcharge for filing the basic filing fee on a date later than the filing date of the application (37 C.F.R. § 1.16(e))	_____
<i>and/or</i>	
<input type="checkbox"/> Surcharge for filing the oath or declaration on a date later than the filing date of the application (37 C.F.R. § 1.16(e))	_____
<input type="checkbox"/> Extension of term	_____
<input type="checkbox"/> first month	_____
<input type="checkbox"/> second month	_____
<input type="checkbox"/> third month	_____
<input type="checkbox"/> fourth month	_____
<input type="checkbox"/> fifth month	_____
<input checked="" type="checkbox"/> Excess claims	<u>\$105.00</u>
<input type="checkbox"/> Issue fee	_____
<input type="checkbox"/> Petition fee	_____
<input type="checkbox"/> Patent maintenance fee	_____
<input type="checkbox"/> first maintenance fee	_____
<input type="checkbox"/> second maintenance fee	_____
<input type="checkbox"/> third maintenance fee	_____
<input type="checkbox"/> Patent maintenance fee surcharge	_____
<input type="checkbox"/> Other _____	_____
_____	_____
_____	_____
_____	_____
<b>TOTAL REFUND REQUESTED</b>	<u>\$105.00</u>

(Request for Refund (Improper Charge of Credit Card Account) [19-4]—page 2 of 3)

**III. EXPLANATION OF WHY CONTESTED CHARGE IS IN ERROR**

Application was filed on 27 February 2004. Application was filed with four (4) independent claims and a check in the amount of \$430.00 (see copy of Transmittal Letter and copy of return receipt postcard). On 27 August 2008 an Amendment was filed with the U.S. Patent and Trademark Office deleting independent Claim 12 and adding independent Claim 14 and dependent Claim 15. (a copy of the Amendment and the return receipt postcard are included). No additional fee is required for this Amendment as the number of independent claims has not been changed and the total number of claims is less than twenty.

**IV. MANNER OF REFUND**

Please make refund by

☒ crediting Account No. 19-3550

☐ crediting credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should not be included on this form as it may become public.

☐ refunding payment.

  
SIGNATURE OF PRACTITIONER

Reg. No.: 48,498

Mark D. Swanson / Pauley Petersen & Erickson  
(type or print name of practitioner)

Tel. No.: ( 847 ) 490-1400

2800 West Higgins Road

P.O. Address

Customer No.: 42419

Hoffman Estates, Illinois 60169

(Request for Refund (Improper Charge of Credit Card Account) [19-4]—page 3 of 3)

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Mail Stop PATENT APPLICATION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Case Docket No. IIT-203

Express Mail No.: EV372472087US

Date of Deposit: 27 February 2004

# COPY

Sir:

Transmitted herewith for filing is the patent application of

Inventor(s): Xian-He SUN et al.

For: METHOD OF INFORMING A CALLEE OF AN ATTEMPTED TELEPHONE CALL BY MEANS  
OF INTERNET PROTOCOL MESSAGING

Enclosed are:

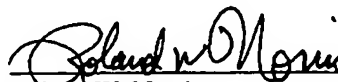
- ☒ New Patent Application including: A cover page, twenty-five (25) pages of specification, four (4) pages of claims (Claims 1-13), one (1) page of Abstract, and four (4) sheets of drawings (Figs. 1-7)
- ☒ Executed combined Declaration, Power of Attorney and Petition, three (3) pages
- ☒ Certificate of Mailing by Express Mail, two (2) pages
- ☒ Recordation Form Cover Sheet, together with executed Assignment Document, three (3) pages, and a check in the amount of \$40.00 to cover the recordal of Assignment fee.
- ☐ Information Disclosure Statement, together with Form PTO-1449 ( page(s)) and a copy of each and every cited reference.
- ☒ Return Receipt Postcard.

The filing fee has been calculated as shown below:

	COL. 1		COL. 2	SMALL ENTITY		OR	LARGE ENTITY	
FOR:	NO. FILED		NO. EXTRA	RATE	FEE	OR	RATE	FEE
BASIC FEE					\$385	OR		\$770
TOTAL CLAIMS	13	less 20	0	X 09 =	0	OR	X 18 =	
INDEPENDENT CLAIMS	4	less 3	1	X 45 =	45	OR	X 86 =	
MULTIPLE DEPENDENT CLAIMS PRESENTED				145 =		OR	+290 =	
* IF THE DIFFERENCE IN COL. 1 IS LESS THAN ZERO, ENTER "0" IN COL. 2				TOTAL	\$430.00	OR	TOTAL	

- ☒ A check in the amount of \$430.00 (Small Entity Status) to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-3550. A duplicate copy of this sheet is enclosed.
  - ☒ Any additional filing fees required under 37 CFR 1.16.
  - ☐ Any patent application processing fees under 37 CFR 1.17.

Pauley Petersen & Erickson  
2800 W. Higgins Road, Suite 365  
Hoffman Estates, Illinois 60195  
Phone (847) 490-1400  
Fax (847) 490-1403

  
Roland W. Norris  
Registration No. 32,799

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Mail Stop PATENT APPLICATION, Commissioner for Patents  
P.O. Box 1450, Alexandria, VA. 22313-1450

P425/jls

Please affix the USPTO receipt stamp hereon as evidence of receipt of the following enclosed papers.

- Transmittal Letter, in duplicate
- New Patent Application including: A cover page, twenty-five (25) pages of specification, four (4) pages of claims (Claims 1-13), one (1) page of Abstract, and four (4) sheets of drawings (Figs. 1-7)
- Executed combined Declaration, Power of Attorney and Petition, three (3) pages
- One (1) Recordation Form Cover Sheet, together with executed Assignment Document, three (3) pages and a check in the amount of \$40.00 to cover the recordal of Assignment fee
- A check in the amount of \$430.00 (Small Entity Status) to cover the filing fee
- Certificate of Mailing by Express Mail, two (2) pages

All by Express Mail No. EV372472087US mailed on 27 February 2004.

Applicants: Xian-He SUN et al.

Title: METHOD OF INFORMING A CALLEE OF AN ATTEMPTED TELEPHONE  
CALL BY MEANS OF INTERNET PROTOCOL MESSAGING

IT-203 ✓

Roland W. Norris

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Xian-He SUN  
Vijay K. GURBANI

Serial No.: 10/788,620

Filing Date: 27 February 2004

Title: METHOD OF INFORMING A  
CALLEE OF AN ATTEMPTED  
TELEPHONE CALL BY  
MEANS OF INTERNET  
PROTOCOL MESSAGING

Customer No.: 42419

Group No.: 2614

Examiner:  
Hemant Shantilal Patel

AMENDMENT

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

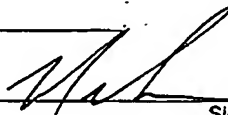
Dear Sir:

In response to the Office Action mailed 28 April 2008, please amend the  
subject Patent Application as follows.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 on

27 August 2008

27 August 2008  
Date

  
Signature

IIT-203

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### AMENDMENT TO THE CLAIMS

1. (Currently Amended) A method of providing communication between a telephone caller and a callee of the telephone call, comprising:

[[a)]] linking a switched telephone network with an internet network via a telephone network/internet domain network interface;

~~b) detecting receiving an attempted call at a switching center~~ within the switched telephone network;

~~determining that the attempted call cannot be routed beyond the switching center;~~

~~e) upon detection of the attempted call,~~ having the switched telephone network inform the telephone network/internet domain network interface to provide a message reporting details of the attempted call to the callee via the internet network.

2. (Original) The method of providing communication between a telephone caller and a callee of the telephone call according to Claim 1, wherein the switched telephone network is a public switched telephone network.

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3. (Original) The method of providing communication between a telephone caller and a callee of the telephone call according to Claim 2, wherein the internet network is the public Internet.

4. (Currently Amended) The method of providing communication between a telephone caller and a callee of the telephone call according to Claim 3, wherein the public switched telephone network informs the telephone network/internet domain network interface to provide the message via an Internet protocol to the callee of the public switched telephone network call when an abnormality is detected in the public switched telephone network which prevents the public switched telephone network from ~~completing the call connection between the caller and the callee~~ routing the call beyond the switching center.

5. (Original) The method of providing communication between a telephone caller and a callee of the telephone call according to Claim 4, wherein the telephone network/internet domain network interface provides the message via an Internet protocol to a caller-selected list of recipients as well as the callee of the public switched telephone network call.

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6. (Original) A method of providing communication between a telephone caller and a callee of the telephone call according to Claim 1, wherein the callee informs at least one of the public switched telephone network or the Internet domain network interface to provide the message to the callee in real time via an Internet protocol when the attempted call is intended for the telephone number of the callee.

7. (Original) A method of providing communication between a telephone caller and a callee of the telephone call according to Claim 1, wherein the message details at least one of the telephone number trying to reach the callee, the caller identification of the telephone number trying to reach the callee, and the time of the attempted call.

8. (Original) A method of providing communication between a telephone caller and a callee of the telephone call according to Claim 1, wherein the message is an Instant Message provided in real time.

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9. (Original) A method of providing communication between a telephone caller and a callee of the telephone call according to Claim 1, wherein the message is a text message.

10. (Original) A method of providing communication between a telephone caller and a callee of the telephone call according to Claim 1, wherein the message is an email.

11. (Currently Amended) A method of providing communication between a telephone caller and a callee of the telephone call, comprising:

[[a))] linking a public switched telephone network with an Internet domain network via a service control point extension for the public switched telephone network and an SIP proxy server for an Internet domain network service provider;

[[b))] detecting at a switching center of the public switched telephone network an attempted ~~public-switched-telephone-network~~ (~~public-switched-telephone network~~) call within the public switched telephone network;

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e) ~~upon detection of the attempted public switched telephone network call,~~ determining that the attempted call cannot be routed beyond the switching center;  
and

having the public switched telephone network inform the Internet domain network service provider to provide a message reporting details of the attempted call in real time to the callee of the public switched telephone network call via an Internet protocol.

12. (Canceled)

13. (Currently Amended) A method of providing crossover services, between an internet domain and a switched telephone network domain comprising the steps of:

a) starting an IM agent for a caller on an Internet-capable device to express interest in providing outgoing call notifications of the caller to the callee or other designated phone lines;

b) having the IM agent register the preference of the caller with the telephone network to inform callees about an attempt by the caller to call the callee or any of the designated telephone lines,

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c) having the telephone network authenticate the IM agent and register the Internet address of the IM agent and the preferences of the caller;[[.]]

d) having the telephone network undertake appropriate actions to ensure that outgoing calls to the callee or designated telephone lines identified in step b) result in a notification action to the callee list when a telephone network service failure is detected within the telephone network and a voice-based communication cannot be delivered to the callee through the telephone network;

e) executing the actions in Step d) when a telephone network ~~interruption/service~~ service failure is detected within the telephone network including having the telephone network capture the incoming call information; ~~and~~

f) automatically creating a message out of the ~~incoming~~ outgoing call information;

g) routing the message through the Internet to the Internet address of the IM agent of the callee or designated telephone lines registered in step c); and

h) displaying the message in Internet-capable devices of the callee, or of persons on the list of designated telephone lines, wherein the message through the Internet is the only message received by the callee or the persons on the list of designated telephone lines.

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14. (New) A method of providing communication between a telephone user and an Internet user, comprising:

linking a public switched telephone network with an Internet domain network via a service control point extension for the public switched telephone network and an SIP proxy server for an Internet domain network service provider;

detecting a detection point within the public switched telephone network caused by a telephone of the telephone user, wherein the detection point indicates that the telephone user disconnected the telephone before the public switched telephone network is able to complete any call;

having the public switched telephone network inform the Internet domain network service provider to provide a message to the Internet user reporting the detection point of the telephone user via an Internet protocol.

15. (New) The method of Claim 14, wherein the detection point indicates the telephone user abandoned the telephone use before signaling any call was completed.

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### REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks.

No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims is less than twenty.

### Request for Telephone Interview

Applicants kindly request the Examiner to contact the undersigned at (847) 490-1400 to schedule a telephone interview, to discuss the merits of this Patent Application.

### Amendment to the Claims

Claims 1 and 11 have been amended to recite a step of determining that the attempted call cannot be routed beyond the switching center. Support for this Amendment can be found throughout the Patent Application, such as at page 4, first full paragraph. Claim 4 has been amended for clarity in view of amended Claim 1.

Claim 13 has been amended to recite that a voice-based communication cannot be delivered to the callee through the telephone network, the automatic creation of a message out of the outgoing call information, and that the message through the

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Internet is the only message received by the callee or persons on a list of designated telephone lines. Again the support for this Amendment can be found throughout Applicants' Specification, which explains that attempted calls can be answered by voicemail or may not be deliverable (page 1) and that the invention automatically sends an Internet message when the attempted call cannot be routed to reach the callee (either directly or through voice messaging).

New Claims 14 and 15 have been added and find support at, for example, page 9, last paragraph, page 12, last paragraph, page 13, first paragraph, and Table 1 on page 13.

No new matter has been added to the claims by this Amendment.

#### **Claim Objections**

Claim 13 has been amended to remove the unintended period, thereby rendering the objection moot.

#### **Claim Rejections - 35 U.S.C. §112**

The term "telephone network/internet domain" is the "name" of the network interface. Applicants believe that one of ordinary skill in the art would

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understand the terminology use, and that the use of the term "telephone network/internet domain" does not render the claim indefinite or unclear.

Claim 13 has been amended and no longer includes the objectionable term, thereby rendering the rejection moot.

Applicants believe that the above Amendment and comments overcome the rejection of Claims 1-10 and 13.

#### **Claim Rejections - 35 U.S.C. §102**

The rejection of Claims 1-4 and 6-11 under 35 U.S.C. §102(e) as being anticipated by Lamb et al., U.S. Patent 6,747,970, is respectfully traversed.

The Lamb et al. Patent discloses smart processing of a telephone call by a user agent, including forwarding the call to a further call destination identified by the callee (i.e., call forwarding to a cell phone) (Col. 33, line 58, through col. 35, line 40). The user agent also can send an email or instant message that a call was received but not forwarded (Col. 51, lines 28-32). In the Lamb et al. Patent, the call reaches the callee, and the callee's user agent is programmed how to handle the received call.

Applicants' claimed invention is intended to handle the situation where the call cannot be completed. In other words, the user agent would not receive the call and would not know to send a message. The Lamb et al. Patent does not teach or

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suggest a method of communicating, by way of an Internet connection, a call that cannot be routed from a switching center to the callee. For at least this reason, the Lamb et al. Patent does not anticipate Claims 1-4 and 6-11.

Favorable reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of Claims 1-3, 6-9, 12, and 13 under 35 U.S.C. §102(e) as being anticipated by Zafar et al., U.S. Patent 7,142,646, is respectfully traversed.

The Zafar et al. Patent discloses a voice mail alert system, whereby an Instant Message or other alert is sent when the user's voice mail system is accessed by a caller (Col. 7, lines 33-65). As discussed above, Applicants' claimed invention is directed to a method where the call cannot be completed, i.e., the call cannot be routed beyond a switching center (Claim 1) and thus never reaches the callee's voice mail system. The Zafar et al. Patent does not teach or suggest a method of communicating, by way of an Internet connection, a call that cannot be routed from a switching center to the callee. For at least this reason, the Zafar et al. Patent does not anticipate Claims 1-3 and 6-9.

Claim 13 has been amended to recite that a voice-based communication cannot be delivered to the callee through the telephone network, and that the message

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Serial No.: 10/788,620

through the Internet is the only message received by the callee or the persons on the list of designated telephone lines. In the Zafar et al. Patent, the IM messaging is activated once the voice mail system is accessed by a callee. Therefore, the Zafar et al. Patent system operates using deliverable voice-based communications, and does not anticipate Applicants' claimed invention.

Favorable reconsideration and withdrawal of this rejection are respectfully requested.

#### **Claim Rejections - 35 U.S.C. §103**

The rejection of Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Lamb et al., U.S. Patent 6,747,970, in view of Adamczyk, U.S. Patent 7,283,620, is respectfully traversed.

Claim 5 depends from Claim 1 and is patentable for at least the same reasons as discussed above. The teachings of the Adamczyk Patent in combination with the Lamb et al. Patent do not overcome the deficiencies discussed above.

#### **New Claims**

New Claims 14 and 15 have been added and are patentable over the prior art of record. As discussed above, the prior art of record does not disclose or

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Serial No.: 10/788,620

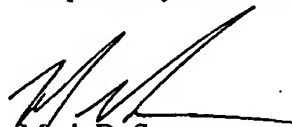
suggest sending an Internet-based message when a call to a callee cannot be completed. By this same reasoning, the prior art of record also does not provide or suggest sending a message based upon a detection point that indicates that the telephone user disconnected the telephone before the public switched telephone network is able to complete any call.

### Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed or resolved in this response, the undersigned attorney again requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,

  
Mark D. Swanson  
Regis. No. 48,498

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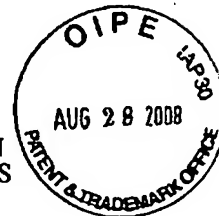
P400/clb

Please affix the USPTO receipt stamp hereon as evidence of receipt of the following enclosed papers.

- Amendment (14 pages)
- Petition for Extension of Time for Filing of Response Under Rule 1.136(a) (2 pages), in duplicate
- A check in the amount of \$60.00 to cover the Petition for Extension of Time fee

All by Certificate of Mailing dated 27 August 2008.

Applicants: Xian-He SUN et al.  
Serial No.: 10/788,620  
Filing Date: 27 February 2004  
Title: METHOD OF INFORMING A CALLEE OF AN  
ATTEMPTED TELEPHONE CALL BY MEANS  
OF INTERNET PROTOCOL MESSAGING  
Customer No.: 42419



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Mark D. Swanson

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**Deposit Account Statement**

Requested Statement Month: October 2008  
 Deposit Account Number: 193550  
 Name: PAULEY PETERSEN & ERICKSON  
 Attention:  
 Street Address 1: 2800 WEST HIGGINS ROAD  
 Street Address 2: SUITE 365  
 City: HOFFMAN ESTATES  
 State: IL  
 Zip: 60195  
 Country: UNITED STATES

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
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10/08	11861	PCT/US08/79136	ITW-21524-PCT	1601	\$300.00	\$6,146.50
10/08	11862	PCT/US08/79136	ITW-21524-PCT	1602	\$1,800.00	\$4,346.50
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10/14	14249	12250175	RP-118-CON	1111	\$540.00	\$7,364.50
10/14	14250	12250175	RP-118-CON	1311	\$220.00	\$7,144.50
10/15	4509	78435185	WCTL-8001	7003	\$100.00	\$7,044.50
10/16	3296	PCT/US08/79970	AFC-107-PCT	1601	\$300.00	\$6,744.50
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10/16	3298	PCT/US08/79970	AFC-107-PCT	1709	\$220.00	\$5,287.50
10/16	15	11922365	RP-104	1617	\$130.00	\$5,157.50

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10/16 9579	E-REPLENISHMENT	9203	-\$5,500.00	\$10,657.50
10/16 9614	6881461 CD-127	2551	\$490.00	\$10,167.50
10/16 9626	6220504 CD-105	2552	\$1,240.00	\$8,927.50
10/16 9644	6220505 CD-109	2552	\$1,240.00	\$7,687.50
10/16 10272	77593860 NA-8060	7001	\$325.00	\$7,362.50
10/16 12599	2652343 RSG-8100	7205	\$200.00	\$7,162.50
10/16 12600	2652343 RSG-8100	7208	\$400.00	\$6,762.50
10/17 7	11887850	9204	-\$50.00	\$6,812.50
10/20 5656	61106446 DCP-113-P	2005	\$110.00	\$6,702.50
10/21 5272	77596394 KPAG-8001	7001	\$325.00	\$6,377.50
10/21 6354	77596443 KPAG-8002	7001	\$325.00	\$6,052.50
10/21 6872	77596472 KPAG-8004	7001	\$650.00	\$5,402.50
10/22 5866	12255420 ITW-21526	1011	\$330.00	\$5,072.50
10/22 5867	12255420 ITW-21526	1111	\$540.00	\$4,532.50
10/22 5868	12255420 ITW-21526	1311	\$220.00	\$4,312.50
10/22 5	11312196 ZAC-103	2252	\$225.00	\$4,087.50
10/22 22	12181148	9204	-\$83.00	\$4,170.50
10/23 2415	E-REPLENISHMENT	9203	-\$5,000.00	\$9,170.50

START	SUM OF	SUM OF	END
BALANCE	CHARGES	REPLENISH	BALANCE
\$5,226.50	\$17,689.00	\$21,633.00	\$9,170.50

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